

REMARKS

Claims 1-13 are pending in the present application.

Claims 1-13 are rejected; all rejections are traversed.

Claims 1, 9 and 10 were amended. A limitation of previous claim 9 was added to claim 1 and 10. Claim 9 was amended to add a limitation supported, *e.g.*, in paragraph 0020 of the specification as filed.

Reconsideration of the claims is respectfully requested.

CLAIM REJECTIONS -- 35 U.S.C. § 102

Claims 1, 3, 4-13 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application No. 2004/0045787 A1 to *Zimmerman*, hereinafter “*Zimmerman*.” This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-76 (8th ed., rev. 4, October 2005) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

The current rejection states:

The coin apparatus disclosed by Zimmerman incorporates sensors 11 mounted at predetermined heights on one side of receptacle 2 in

which coins are arranged in a stack. Said sensors comprising light transmitting device for transmitting light into said receptacle, wherein said light is reflected off coins 3 when present (see Figure 6). The predetermined heights of sensors 11 are correlated to predetermined coin values, as well as, to the states of depletion, near depletion and filled to capacity of the receptacles. Signals resulting from the presence of [sic] absence of coins are sent to evaluator 6 which counts the numbers of coins in the receptacles 2 and maintains running totals of said coins. Access ports and masts constructed in receptacle 2 to regulate transmission of light from and to sensor 11 are an inherent [sic] in the operation of said sensor.

Claim 1 was amended to include a limitation formerly found in dependent claim 9, of "a mask mounted on said sensor and having apertures constructed therein aligned with said transmitting and receiving devices, to isolate the receiving device from exposure to transmitted light prior to reflection." This limitation is not taught or suggested by the art of record.

The Examiner argues, reproduced above, that this is an inherent limitation. The Examiner is incorrect. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted, emphasis added).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Of course, the Examiner has made no showing that a mask as claimed is necessarily present in the prior art references, as would be required to find this claimed feature to be inherent. As both Zimmerman and Mothwurf use transmitter/receiver pairs for coin detection without using any mask, it is abundantly clear that the claimed mask is not a necessary feature in the operation of such a sensor.

The rejections of claims 1-9 are therefore traversed.

Claim 10 has been amended to include a limitation similar to that added to claim 1 above, and distinguishes over all art of record for similar reasons. The rejections of claims 10-11 are therefore also traversed.

Applicant respectfully notes that the amendment to claim 1 should not cause any further search or consideration justifying a final Office Action over new art, since the combination of limitations in amended claim 9 has already been fully searched and examined in the current Office Action. While it is certainly true that this rejection has been overcome, and perhaps the Examiner will wish to do a further search, this is not necessitated by the amendment. This is likewise true of the limitation added to claim 10, as this limitation has already been searched and examined in the context of claim 9.

Claim 13 requires “counting the number of dispensing operations and subtracting said number of dispensing operations from said stored number of coins in a full stack to determine the number of coins remaining in the stack.” This limitation is not taught or suggested by Zimmerman and Mothwurf. Certainly Zimmerman’s “evaluation device 6” is not described as performing these counting and subtracting operations.

The rejection of claim 13 is therefore also traversed.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 rejection with respect to these claims.

CLAIM REJECTIONS -- 35 U.S.C. § 103

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zimmerman in view of U.S. Patent No. 5,755,618 to *Mothwurf*, hereinafter “Mothwurf.” The Applicant respectfully traverses the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when

combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

As the limitation discussed above in amended parent claim 1 is also not taught or suggested by Mothwurf, this rejection is also traversed.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

CONCLUSION

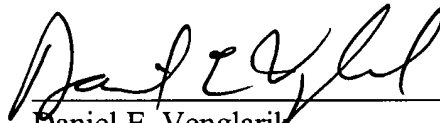
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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